

REMARKS

The undersigned attorneys for the Applicant wish to express their appreciation for the courtesies extended by Examiner Thaler during the telephone interview on August 11, 2004 during which issues pertaining to the rejected claims were discussed.

Prior to present amendment claims 7, 13 and 21 were pending in this application and claims 17-20 have been previously withdrawn from consideration. Claim 13 has been rejected under 35 U.S.C. §112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7, 13 and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Chin '233 in view of Jones '616. While the Applicant respectfully disagrees with the above rejections, claims 7, 13 and 21 have been cancelled by present amendment without prejudice and new claims 22-32 are presented to more clearly recite the patentable features of the present invention. All claims 22-32 do not add new matter and are fully supported by the specification and the drawings.

Claim 22 is the only independent claim and it specifically recites "a flexible hood extending from the distal end of the second lumen and gradually tapering down towards the distal end of the first lumen, the hood maintaining its tapered configuration even in the absence of a medical instrument in the second lumen, to form a smooth transition surface adjacent the transparent tip to facilitate blunt tissue dissection and maneuverability."

The hood as claimed thus exhibits a tapered transition contour on its own without a surgical instrument extending from the open distal end of the associated second lumen.

It should be recognized that the above-described aspects of the claimed invention facilitate easy tissue dissection in response to advancing the tip and the hood as well as other advantages, as specifically explained on page 3, lines 1-9 and page 10, lines 2-13 of the specification.

These aspects of the claimed invention are not disclosed or even suggested by the cited references considered either alone or in the combination proposed by the Examiner. In fact, the cited references teach away from the features of the present invention and do not provide any motivation or incentive to combine them. Specifically, the Examiner has already admitted that Chin '233 fails to teach at all any flexible hood coupled to the distal end of the second lumen. The Examiner, however, mistakenly contends that the missing teaching is supplied by the collapsible lumen of Jones '616 patent. Applicant respectfully disagrees.

First, the '616 patent does not disclose a flexible hood as claimed at all. Instead, it discloses an endoscope with fully collapsible second lumen that is specifically and purposefully designed to be completely and uniformly collapsed during insertion and advancing of the endoscope (when no medical instrument is present in its channel). Consistent with the purpose of the reference, the channel 20 is collapsed along its entire length, which is "similar in length to the length of the endoscope 10" (see col. 3, line 67 to col. 4, lines 1-2 of the '616 patent). The stated goal of the '616 patent is to achieve a smaller insertion diameter throughout the entire lengths of the endoscope, therefore it admits that "[A] significant feature of the collapsible channel 20, as shown in FIGS. 1

and 2, is its ability to collapse upon itself and then be inserted into a body orifice entering a body cavity in a flattened form” (see col. 4, lines 37-40).

It is clear that the ‘616 reference has nothing to do with tissue dissection, and therefore, it is not concerned at all with solving issues related to tissue dissection and adding features, such as tapered contour, that are beneficial in the process of tissue dissection. As a result, contrary to the Examiner’s analysis of this reference, there is not an iota of suggestion here that a tapered transition contour is formed along the cannula in the absence of an inserted instrument. Since neither Chin ‘233 nor Jones ‘616 alone disclose or suggests the flexible hood feature of the present invention, any combination of these two references could not and does not yield or even suggest this feature either.

At best, then, these combined references would appear to replace the cannula 9 of Chin ‘233 (with its lumen for an endoscope and an eccentric lumen for a surgical instrument) with an endoscope alone and an attached collapsible channel of Jones ‘616, but without any tapered hood, in a combination that could only be derived from the Examiner’s hindsight reconstruction of these elements using instructions found only in Applicant’s own specification. The deficient disclosures of these references thus fail even to establish a *prima facie* basis from which a proper determination of obviousness could be made. It is therefore respectfully submitted that independent claim 22 is patentable over the cited references.

New dependent claims 23-32 all variously depend from the patentable independent claim 22 and further recite additional patentable features of the present invention. It is

therefore respectfully submitted that claims 22-32 are also patentably distinguishable over the cited art and are in condition for allowance.

Reconsideration and allowance of claims 22-32 are respectfully solicited. The Examiner is invited to contact the undersigned if any minor questions arise that could be resolved over the telephone.

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